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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/001,389 | 10/23/2001 | Charles K. Wike JR. | 9423 | 1315 |

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PAUL W. MARTIN
LAW DEPARTMENT, WHQ-5E
1700 S. PATTERSON BLVD.
DAYTON, OH 45479-0001

| EXAMINER | |
|---|---|
| LE, UYEN CHAU N | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/001,389 | WIKE ET AL. | |
| | Examin r | Art Unit | |
| | Uyen-Chau N. Le | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *25 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 25 September 2003.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4, 8-9 and 15-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al (US 5,594,228) in view of Bergman et al (US 5,469,142).

Re claims 1-4, 8-9 and 15-16: Swartz et al discloses a system and method of operating of a self-checkout terminal comprising a scanner [10, 144] for scanning a tag 101 having a barcode symbol 103 of an item [102, 120]; an electronic article surveillance deactivator 100 operative to

deactivate an active surveillance tag 126 by a consumer (figs. 9a-10b; col. 19, lines 59+; col. 22, lines 4+); a processor/microcomputer 164, having a memory for storing a database and program instructions, in communication with the scanner 144, causing the processor/microcomputer 164 to scan the item 120 for purchase via the scanner 144 and deactivate the active electronic article surveillance tag 126 (figs. 1 and 7a-9b; col. 10, line 29 through col. 12, line 10 and col. 18, line 4 through col. 21, line 17).

Swartz et al fails to teach or fairly suggest that the system further comprising an electronic article surveillance detector operative to detect whether a scanned item has an active electronic article surveillance tag, wherein the electronic article surveillance detector is associated with the scanner.

Bergman et al teaches an electronic article surveillance detector for determining whether an active electronic article surveillance tag is present at the checkout station (figs. 3-4b; col. 3, line 5 through col. 5, line 6).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an electronic article surveillance detector to detect a presence of an active electronic article surveillance tag as taught by Bergman et al into the self-checkout system of Swartz et al in order to provide Swartz et al with a more versatile system that has a capability of operating in all self-checkout systems (i.e., whether a surveillance tag is present or not). Furthermore, such modification would have been an obvious extension, well within the ordinary skill in the art, as taught by Swartz et al for a more feasible system that allows retailers to have surveillance tag on certain expensive items rather than having surveillance tag attached on every single item which can be very expensive, and therefore an obvious expedient.

5. Claims 5-7, 10-12 and 17-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al as applied to claims 1, 8 and 15 above, and further in view of Bellis Jr. et al (US 2002/0,096,564A1). The teachings of Swartz et al as modified by Bergman et al have been discussed above.

Re claims 5-7, 10-12 and 17-19: Swartz et al/Bergman et al has been discussed above but fails to teach or fairly suggest that the system further comprising a second electronic article surveillance detector associated with a bagwell/security scale of the self-checkout and is operative to determine whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.

Bellis Jr. et al teaches a bagging station 270 including an electronic article surveillance monitor 300 for detecting the presence of an active electronic article surveillance tag and a security scale 290 (page 2, paragraph [0020]; page 4, paragraph [0042] through page 5, paragraph [0059]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an electronic article surveillance detector associated with the bagwell/security scale as taught by Bellis Jr. et al into the teachings of Swartz et al/Bergman et al in order to provide Swartz et al/Bergman et al with a more secure system, which double check/detect the electronic article surveillance tag to ensure that no unpaid/unauthorized items can be taken out of a store/a secure area either by accidentally or intentionally.

6. Claims 13-14 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al as applied to claims 8 and 15 above, and further in

view of Garber et al (US 6,486,780 B1). The teachings of Swartz et al as modified by Bergman et al have been discussed above.

Re claims 13-14 and 20: Swartz et al/Bergman et al has been discussed above but fails to teach or fairly suggest that the electronic article surveillance detector comprising a coil and electronic circuitry/logic that is operative to obtain a signal from the coil indicative of the active electronic article surveillance tag.

Garber et al teaches an electronic article surveillance detector system comprising a coil/an antenna 104, a circuitry/an interrogation source 102 and a detector 106 for obtaining a signal from the coil indicative of the active electronic article surveillance tag (col. 7, lines 3+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a coil and electronic circuitry/logic as taught by Garber et al into the electronic article surveillance detector of Swartz et al/Bergman et al due to the fact that such modification would have been an obvious engineering design variation, well within the ordinary skill in the art, and therefore an obvious extension.

***Response to Arguments***

7. Applicant's arguments filed 25 September 2003 have been fully considered but they are not persuasive.

8. In response to the Applicant's arguments "Swartz assumes that a surveillance tag is present ... it is the surveillance tag that is being scanned ..." (p. 12, last paragraph), the examiner respectfully requests the applicant to further review Swartz, by giving its broadest reasonable interpretation, wherein the symbol 128 (e.g., barcode) is printed on a label and that is which

being scanned (col. 21, lines 14-17), not the surveillance tag that is being scanned. Therefore, a self-checkout system as taught by Swartz meets the limitation of the claimed invention.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Swartz teaches a self-checkout system having a processor 164, a memory , a scanner [10, 144], an electronic article surveillance deactivator 100 to deactivate a surveillance tag 126. However, Swartz is silent with respect to an electronic article surveillance detector operative to detect whether an electronic article surveillance tag is present. The second reference to Bergman et al teaches an electronic article surveillance detector for determining whether an active electronic article surveillance tag is present at the checkout station (figs. 3-4b; col. 3, line 5 through col. 5, line 6). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Swartz et al in view of Bergman et al meets the claimed invention (see the rejection above).

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*
December 07, 2003

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800